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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/826,690	04/05/2001	Joseph Harbaugh	6994-1	4205
7590	04/25/2005		EXAMINER	
Gregory A. Nelson Akerman Senterfitt 222 Lakeview Avenue, Fourth Floor P.O. Box 3188 West Palm Beach, FL 33402-3188			SMITH, TRACI L	
			ART UNIT	PAPER NUMBER
			3629	
DATE MAILED: 04/25/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/826,690	HARBAUGH, JOSEPH	
	<b>Examiner</b>	<b>Art Unit</b>	
	Traci L Smith	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

#### A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-22 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All
  - b) Some \*
  - c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____.   |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____.  | 6) <input type="checkbox"/> Other: _____.                                   |

### **DETAILED ACTION**

1. This action is in response to papers filed on February 22, 2005.
2. Claims 1-5, 7-14 and 21 have been amended.
3. Claims 1-22 are pending.
4. Claims 1-22 are rejected.
5. Objections of the Abstract have been withdrawn.

#### ***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 3,12 and 15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claims site a process of calibrating grades. This process is not described in the specification, it is merely stated that one skilled in the art would know the process. However, after a thorough internet search of the term "calibrated grading" the examiner was unable to find a definition describing how the process works.

#### ***Claim Rejections - 35 USC § 101***

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. Claim1-21rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

10. For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

11. In the present case, claims 1-4, 6-7, 10-16, 18 and 20-21 are just abstract idea and or process and does not involve the incorporation of the technological arts .

12. Mere intended or nominal use of a component, albeit within the technological arts, does not confer statutory subject matter to an otherwise abstract idea if the component does not apply, involve, use, or advance the underlying process.

13. In the present case, claims 5, 8-9, 17 and 19 although they recite technological arts the do not advance the process, they merely deliver information.

***Claim Rejections - 35 USC § 102***

14. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

15. Claims 1, 13 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by [www.gradcollege.swt.edu](http://www.gradcollege.swt.edu) (any linkage on(2000): \*March 4, 2000).

16. As to claims 1 and 13, swt.edu teaches a method for admitting students to a university, who fall below the minimum requirements of standardized tests and GPA's, to the institution while setting conditions on the admission opportunity. Once a student is meets all the requirements of their conditional admittance they are giving an unconditional admission status.(P. 7 l. 9-10, 29-25 and 37-40).

17. As to claim 20 swt.edu teaches a GRE score of 900 or above for regular admission; conditionally admitted even though you may not meet the minimum requirements.(Pg. 7 l. 10, 32-33)

***Claim Rejections - 35 USC § 103***

18. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

19. Claims 2, 4, 7, 14 and 18-19 rejected under 35 U.S.C. 103(a) as being unpatentable over [www.swt.edu](http://www.swt.edu) as applied to claim1, 13 and 20 above, and further in

view of Karen W. Arenson; New York Times, "Opponents of a Change in CUNY

Admissions Policy Helped Pass a Compromise Plan"; November 24, 1999.

20. As to claims 2 and 14 swt.edu teaches a method of conditional admittance using GPA's but fails to teach the standardized test range. Arenson teaches the use of standardized test scores to identify students who don't qualify for regular admission.(Pg 2 ¶ 7-8). It would have been obvious to combine the standardized test scores to identify students who would fall into conditional admittance, as test scores are a normal index score to use when considering students for regular admissions.

21. As to claim 4, swt.edu teaches the method of conditional admission but fails to teach the satisfactory criteria for at least one examination. Arenson teaches a method of placement tests to determine level of work(Pg. 2 ¶ 7). It would have been obvious to set satisfactory criteria for the examinations so as to have a guide to identify a students progress or success indicator.

22. As to claims 7 and 18, swt.edu teaches conditions for which admission is based on, however it fails to teach instruction environment. Arenson teaches enrolling students in remedial classes on the senior campus(Pg. 2 ¶ 8). It would have been obvious to combine remedial classes into the main campus program so as to provide the conditionally admitted students with the skills they would need to meet the satisfactory requirements and complete regular level courses.

23. Claims 5-6, 8-9, 16-17 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over swt.edu and Arenson as applied to claims 2-4, 7-8, 14 and 18-19 above, and further in view of US Patent 6, 146,148, Nov. 14 2000, Stuppy.

24. As to claims 5 and 16 Arenson fails to teach a method of instruction as condition of admittance but fails to teach distance instruction. Stuppy teaches a method of automated instruction creating a student workbook(C.1 l. 67, C. 2 l. 1, 6). It would have been obvious to combine the conditional instruction with the technology of distance education to make it more cost effective and easily accessible.

25. As to claims 6 and 17 Arenson teaches a method of instruction for conditionally admitted applicants but fails to teach an electronic method for delivering instruction. Stuppy teaches electronically generating instructional material(C. 2 l. 3-5).

26. Stuppy further teaches collecting student data in response to instructional material(C. 2 l. 7-8).

27. Stuppy also teaches collecting student data from student to teacher.(C. 2. l.20-21). It would have been obvious to combine the technology used by Stuppy in Arenson' instruction method so as to conserve time and money.

28. As to claims 8 and 19 Arenson fails to teach remote online instruction. Stuppy teaches instructors teaching a plurality of students at different arrangements in completely different locations.(C. 5 l. 15-16).

29. Stuppy further teaches teacher and student participation online(C. 5 l.21-22)

30. It would have been obvious to combine the online technologies with the teachings of Arenson for a more interactive, accessible and cost-effective instructional environment.

31. As to claim 9 Arenson fails to teach a method of administering and grading an examination online. Stuppy teaches a method of mastery testing to determine the skill

of students during a later session with results stored and used on the server(C. 7 l. 41-46). It would have been obvious to combine the electronic technologies of Stuppy to the teachings for Arenson to have a method of assessing student level in an efficient and accessible manner.

32. As to claim 21 swt.edu teaches a paper method of admitting applicants conditionally. Swt.edu fails to teach an electronic method of admitting the students and completing the conditions of the admission electronically. Stuppy teaches an automated assessment and testing through a multimedia interface and answers questions electronically. Tests are scored and analyzed by computer then utilized to generate a program suited for the student. (C. 4. l. 40-56)

33. It would have been obvious to combine the online teachings of Stuppy with swt.edu to advance the process with the use of technology as well as a more accessible and efficient process.

34. Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over swt.edu and Arenson as applied to claims 2, 4, 7, 14 and 18-19 above, and further in view *New Models to Assure Diversity, Fairness and Appropriate Test Use in Law School Admissions. A Publication of the Law School Admission Counsel*; October 1999(hereafter referred to as LSAC).

35. As to Claim 10 swt.edu teaches an admission compiling process but it fails to teach the method with the use of LSAT scores. LSAC teaches a method of using LSAT scores as a part of the admission decision making process.(Pg. 14 ¶ 7, 'Academic Factors'). It would have been obvious to combine the teachings of LSAC to swt.edu

since swt.edu's process was for general graduate programs and the LSAT a specific assessment test for Law schools.

36. As to claim 11 Arenson teaches a method of using test scores and GPA's in the admissions decision process but fails to teach the process using the LSAT specifically. LSAC teaches a method of using the LSAT as an admissions criteria(Pg. 14 ¶ 6-7). It would have been obvious to combine the teachings of Arenson's admissions process with that of the LSAC as applicants applying to Law school would take the Law School Assessment Test(LSAT) as part of the requirements for admission.

37. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over swt.edu as applied to claims 1, 13 and 20 above, and further in view of US Patent 6, 088, 686, July 11, 2000; Walker et al.

38. As to claim 22 swt.edu teaches a method for determining a student's qualifications for admissions but it fails to teach an electronic computer process for completing the method. Walker et al teaches a method for electronically submitting an application and performing the steps of the acceptance process.( C. 2. I. 1-8) It would have been obvious to combine the teachings of Walker into swt.edu as they are both the automation of an application review process.

39. Walker et al., further teaches program requirements for new or existing customers that are systematically ranked(A, B, C and D) and recommended decision and required credit policies are appropriately completed(C. 6 I. 45-58). It would have been obvious to combine the teachings of Walker with swt.edu so as to have codes

attached to the required admissions criteria data so a computer program can read and process the information.

40. Walker continues to teach a method of enrolling the applicant for the loan which they have been approved for as an acceptance of the offer and enable the participation in the program (C. 8 I. 51-55; 67-68 & C. 9 I. 1-2). It would have been obvious to combine the enrollment acceptance of Walker with swt.edu so that both the school and the student have an agreement of the admissions condition and are able to begin the course requirements set forth by the admission status.

#### ***Response to Arguments***

41. Applicant's arguments filed February 22, 2005 have been fully considered but they are not persuasive.

42. As to applicants arguments regarding the teachings of "calibrated grading", the applicant gives an explanation of the idea behind the calibrating and that it is well known in the art. However, the applicant fails to point out where the specification it is taught as to how to determine what levels the individuals or multiple tests are separated into. In order for one of ordinary skill to replicate this process that it would require them knowing what the levels are in order to separate the individuals into the appropriate separation.

43. As to applicants arguments regarding 35 USC 101 rejections, if applicant was unsure as to interpret examiners rejection it would have been appropriate to address this issue during the interview held on October 7, 2004. Applicants claims fail to meeting the two prong test in that they fail to positively recite the use of technology via

manipulation of data through ever step of the process. As there is no indication that technology is involved in performing the steps, they could merely be done by pen and paper and human intervention. Examiner has included additional information regarding technological arts with regard to 35 USC 101.

44. As an initial matter, the United States Constitution under Art. I, §8, cl. 8 gave Congress the power to "[p]romote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries". In carrying out this power, Congress authorized under 35 U.S.C. §101 a grant of a patent to "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition or matter, or any new and useful improvement thereof." Therefore, a fundamental premise is that a patent is a statutorily created vehicle for Congress to confer an exclusive right to the inventors for "inventions" that promote the progress of "science and the useful arts". The phrase "technological arts" has been created and used by the courts to offer another view of the term "useful arts". See *In re Musgrave*, 167 USPQ (BNA) 280 (CCPA 1970). Hence, the first test of whether an invention is eligible for a patent is to determine if the invention is within the "technological arts".

45. Further, despite the express language of §101, several judicially created exceptions have been established to exclude certain subject matter as being patentable subject matter covered by §101. These exceptions include "laws of nature", "natural phenomena", and "abstract ideas". See *Diamond v. Diehr*, 450, U.S. 175, 185, 209 USPQ (BNA) 1, 7 (1981). However, courts have found that even if an invention

incorporates abstract ideas, such as mathematical algorithms, the invention may nevertheless be statutory subject matter if the invention as a whole produces a "useful, concrete and tangible result." See *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* 149 F.3d 1368, 1973, 47 USPQ2d (BNA) 1596 (Fed. Cir. 1998).

46. This "two prong" test was evident when the Court of Customs and Patent Appeals (CCPA) decided an appeal from the Board of Patent Appeals and Interferences (BPAI). See *In re Toma*, 197 USPQ (BNA) 852 (CCPA 1978). In *Toma*, the court held that the recited mathematical algorithm did not render the claim as a whole non-statutory using the Freeman-Walter-Abele test as applied to *Gottschalk v. Benson*, 409 U.S. 63, 175 USPQ (BNA) 673 (1972). Additionally, the court decided separately on the issue of the "technological arts". The court developed a "technological arts" analysis:

The "technological" or "useful" arts inquiry must focus on whether the claimed subject matter...is statutory, not on whether the product of the claimed subject matter...is statutory, not on whether the prior art which the claimed subject matter purports to replace...is statutory, and not on whether the claimed subject matter is presently perceived to be an improvement over the prior art, e.g., whether it "enhances" the operation of a machine. *In re Toma* at 857.

47. In *Toma*, the claimed invention was a computer program for translating a source human language (e.g., Russian) into a target human language (e.g., English). The court found that the claimed computer implemented process was within the "technological art" because the claimed invention was an operation being performed by a computer within a computer.

48. The decision in *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* never addressed this prong of the test. In *State Street Bank & Trust Co.*, the court found that the "mathematical exception" using the Freeman-Walter-Abele test has little, if any, application to determining the presence of statutory subject matter but rather, statutory subject matter should be based on whether the operation produces a "useful, concrete and tangible result". See *State Street Bank & Trust Co.* at 1374. Furthermore, the court found that there was no "business method exception" since the court decisions that purported to create such exceptions were based on novelty or lack of enablement issues and not on statutory grounds. Therefore, the court held that "[w]hether the patent's claims are too broad to be patentable is not to be judged under §101, but rather under §§102, 103 and 112." See *State Street Bank & Trust Co.* at 1377. Both of these analysis goes towards whether the claimed invention is non-statutory because of the presence of an abstract idea. Indeed, *State Street* abolished the Freeman-Walter-Abele test used in *Toma*. However, *State Street* never addressed the second part of the analysis, i.e., the "technological arts" test established in *Toma* because the invention in *State Street* (i.e., a computerized system for determining the year-end income, expense, and capital gain or loss for the portfolio) was already determined to be within the technological arts under the *Toma* test. This dichotomy has been recently acknowledged by the Board of Patent Appeals and Interferences (BPAI) in affirming a §101 rejection finding the claimed invention to be non-statutory. See *Ex parte Bowman*, 61 USPQ2d (BNA) 1669 (BdPatApp&Int 2001).

49. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., academic program is taking outside of curriculum and have not received an offer of admission etc.) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

50. Although applicant argues the program is taking outside the curriculum offered by the school and is part of the admissions program this is not how the claims are interpreted. Examiner is able to read claims with the broadest reasonable interpretation. In which case the examiner is reading claims as the abbreviated program is thru the law school. As with such interpretation it would be understood to one skilled in the art that if an individual were enrolled in an abbreviated program at an institution they have been admitted in some manner. It is well known to those in the admissions field that no matter what types of classes (credit or non-credit) a student is taking there is some type of admissions process they must go through so that the institution has a record of what students are enrolled in what programs and courses. It is also noted that it is well known in the art to offer a secondary method, such as a pre-admissions test, to offer a second chance at showing ones skills and abilities. As it is well documented that several factors play a role in how one scores on standardized test such as environment, health, education etc. and is not always a clear indicator of a students ability on that given day.

51. As to applicants arguments that removing the term “conditional admission” is narrowing the scope of the claim, examiner disagrees and states that and admissions program with an abbreviated academic program can still be read as being disclosed in the cited references.

52. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Examiner believes Grad College teaches the identifying and admitting of students, therefore the combinations are appropriate.

53. As to applicants submissions of affidavits under § 1.132 applicant is addressing what is seen by the applicant as a long felt need and commercial success for a process such as that claimed in the instant application. Applicant states that the affidavits point to claims 10-12 directed specifically towards Law School admission. Claims 10-12 are dependent claims of claim 1 which maintaining a 35 USC 102 rejection. The fact that the dependent claims are directed towards Law School Admission is merely intended use and does not patentably distinguish itself over the prior art. As to applicants arguments that the additional secondary considerations are directed towards the admission of minorities into law school is not supported by the applicants disclosure. The examiner holds that it would have been obvious to combine the teaches as stated above and used admissions process from other graduate and post-graduate programs currently being used.

54. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

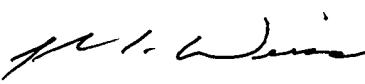
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Traci L Smith whose telephone number is before April 12, 2005 (703)605-1155 or 571-272-6809 after April 12, 2005. The examiner can normally be reached on Monday-Thursday 6:00 am-4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 703.308-2702/571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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